

Application No. 09/937,078  
Brief of Appeal dated February 5, 2007  
Relating to Office Action of December 4, 2006



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 09/937,078  
Confirmation No. : 8017  
Applicant : Mark E. Hooper et al.  
Filed : January 14, 2002  
TC/A.U. : 2623  
Examiner : Peter C. Wilder  
Docket No. : 04834-007-US-02

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

**APPEAL BRIEF UNDER 37 CFR § 41.37**

Madam, Sir:

This appeal brief is in furtherance of the Notice of Appeal that was filed in the above-captioned application on **January 18, 2007**.

Appellant files herewith an Appeal Brief (submitted in triplicate) under **37 CFR § 41.37** in connection with the aforementioned application, wherein claims **28 to 38** were finally rejected in the Office Action mailed December 4, 2006.

**STATUS OF THE APPLICANT**

Pursuant to 37 CFR § 1.27(a), this application is on behalf of other than a small entity.

**FEE FOR FILING A BRIEF OF APPEAL**

Pursuant to 37 CFR § 41.20(b)(2), the fee for filing the Brief of Appeal is: **\$ 500.00**

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### **TOTAL FEES DUE**

The total fees due are:

Brief of Appeal Fee:           **\$ 500.00**

### **FEE PAYMENT**

The United States Patent and Trademark Office is hereby authorized to charge the amount of **\$US 500.00** to our Deposit Account no. **50-3436** for the payment of the prescribed fees. If any other fees whatsoever are due, the United States Patent and Trademark Office is also hereby authorized to charge any such additional fees to our Deposit Account no. **50-3436**.

I. Real Party in Interest (37 CFR § 41.37(c)(1)(i))

The real party in interest in the appeal is the assignee of the application, Pixnet Inc., which has received its right through an assignment from Pixel System Inc. which has received its right through assignments from the inventors Mark E. Hooper, François Cloutier and Claire Langlois.

II. Related Appeals and Interferences (37 CFR § 41.37(c)(1)(ii))

There are no other related appeals or interferences in process or pending before the U.S. Patent and Trademark Office.

III. Status of Claims (37 CFR § 41.37(c)(1)(iii))

The status of the claims set forth after the final Office Action mailed December 4, 2006, was and is as follows:

Withdrawn claims: **none**

Allowed claims : **none**

Rejected claims : **28-38**

Objected claims : **none**

Accordingly, the present appeal is directed to claims **28-38**.

IV. Status of Amendments (37 CFR § 41.37(c)(1)(iv))

Subsequent to the final Office Action of December 4, 2006, Appellant has not filed any amendments in response to the aforementioned Office Action.

V. Summary of Claims Subject Matter (37 CFR § 41.37(c)(1)(v))

For the sake of simplicity, references to the present application will be made using the paragraph numbering of the published application, namely publication no. U.S. 2003/0009762.

Claim 28

Independent claim 28 generally recites a method to display selected multimedia content via remote display systems according to playlists (Fig. 1 and paragraphs [0006] and [0057]). The playlists comprise multiple air time periods (paragraph [0031]) and are stored on display controllers (paragraph [0057]). All the display systems are connected to scheduling servers 200/300/400 (Fig. 1 and paragraphs [0114] and [0115]) and to a transmission control system 100 (Fig. 1 and paragraphs [0114] and [0115]) via a network 600/700 (Fig. 1 and paragraphs [0114] and [0115]).

The method of the present invention comprises the following steps:

- selecting the multimedia content to be displayed (paragraph [0102]);
- storing said multimedia content on said scheduling server (local storage 220/320/420 and paragraph [0103]);
- selecting one of said display screens on which said multimedia content is to be displayed (screens 260/360/460 and paragraph [0104]);
- storing such display screen selection on said scheduling server (local storage 220/320/420 and paragraph [0105]);
- on said scheduling server 200/300/400, determining and storing data related to the availability of said air time periods of said playlists (paragraph [0031]);
- on said scheduling server 200/300/400, inputting and storing data related to the multimedia content preferences of each user of a visual display system (paragraph [0119]);
- on said scheduling server 200/300/400, inputting and storing data related to the air time period preferences of each user in said playlist schedule of a visual display system (paragraph [0119]);
- creating said playlists by optimally correlating said available air time periods, said air time period preferences and said multimedia content preferences (paragraphs [0024], [0025] and [0120]);
- transmitting said stored multimedia content and said playlists to said display controllers connected to said selected display screen (paragraph [0048]);

- displaying said selected multimedia content on said selected display screen according to said playlists (paragraph [0057]).

Claim 29

Independent claim 29 generally describes a system to control the display of multimedia content on remote display sub-systems. Therefore, the system comprises a plurality of remote and out-of-home display systems (Fig. 1 and paragraphs [0006] and [0057]) which are all connected together via a broadband network 600 (Fig. 1 and paragraph [0115]). Each of the display systems comprises an electronic multimedia display screen 260/360/460 (Fig. 1 and paragraph [0116]) which is connected to a display controller which is a CPU (Fig. 1 and paragraph [0116]). Generally, the display screens are adapted to be seen by passers-by (paragraph [0116]).

According to the present system, each display system is adapted to cycle through a playlist of multimedia content (paragraphs [0023] and [0057]). Each playlist has a plurality of air time periods (paragraph [0031]) and each playlist is stored on a respective display system (paragraph [0057]).

The system of the present invention further comprises scheduling servers 200/300/400 (Fig. 1 and paragraphs [0113] and [0114]). The scheduling servers 200/300/400 are connected to the display systems via a transmission control system 100 and a network 600 (Fig. 1 and paragraphs [0114] and [0115]). Each of the scheduling servers 200/300/400 comprises computer processor means, in the form of a CPU 210/310/410 (Fig. 1 and paragraph [0113]), and data storage means, in the form of a local storage 220/320/420 (Fig. 1 and paragraph [0113]).

The system of the present invention further comprises first means for processing data, in the form of in the CPUs 210/310/410 (Fig. 1 and paragraph [0113]), for

determining the availability of the air time periods in the playlists of the display systems (paragraph [0031]).

The system of the present invention further comprises second means for processing data, in the form of in the workstations associated with the scheduling servers 200/300/400 (Fig. 1 and paragraph [0113]), for selecting and reserving air time periods in one or more of the playlists (paragraph [0119]).

The system of the present invention further comprises third means for processing data, in the form of in the form of in the workstations associated with the scheduling servers 200/300/400 (Fig. 1 and paragraph [0113]), for linking the selected multimedia content to the selected air time periods of the playlists (paragraph [0121]). The third means also comprises means for transmitting, in the form of network 700, transmission control system 100 and network 600 (Fig. 1 and paragraphs [0114] and [0115]), the playlists and the multimedia content to the display systems (paragraph [0048]).

The system of the present invention further comprises fourth means for inputting, in the form of workstations 230/235/330/335/430/435 (Fig. 1), and storing, in the form of local storage 120 (Fig. 1 and paragraph [0119]) the multimedia preferences of each user (paragraph [0119]).

The system of the present invention further comprises fifth means for inputting, in the form of workstations 230/235/330/335/430/435 (Fig. 1), and storing, in the form of local storage 120 (Fig. 1 and paragraph [0119]) the air time periods preferences of each user (paragraph [0119]).

Finally, the system of the present invention further comprises sixth means, in the form of CPUs 210/310/410, for determining the optimal playlist for each display system by optimally correlating the available air time periods, the multimedia and air time

periods preferences of each user (paragraphs [0024] and [0025] and also [0120] and [0121]).

Claims 30-38

Claim 30, depending on claim 29, further recites the visual display sub-systems (paragraph [0057]) of the present invention further comprise means, in the form a CPU (paragraph [0116]), that will request the transmission of multimedia content or a portion thereof if the multimedia content, or the portion thereof, is not stored on the storage means, in the form a of storage mechanism (paragraph [0116]), of a display sub-system (paragraph [0064])

Claim 31, depending on claim 29, further recites that the system of the present invention further comprises means, in the form of workstations 200/300/400 (paragraphs [0100] and [0118]) to input and store demographic data in relation to the geographical location of the display sub-systems.

Claim 32, depending on claim 29, further recites that the sixth means for processing data in the form of scheduling servers 200/300/400 and their associated CPUs 210/310/410 (paragraph [0113]) comprise two further means, generally embodied in the form of the CPUs 210/310/410 (paragraph [0113]), to first determine, for each display, the duration of any unreserved air time period and to then fill the unreserved air time periods, if any, with compatible content (paragraph [0033]).

Claim 33, depending on claim 29, further recites that the sixth means for processing data in the form of scheduling servers 200/300/400 and their associated CPUs 210/310/410 (paragraph [0113]) comprise two further means, generally embodied in the form of the CPUs 210/310/410 (paragraph [0113]), to first determine, for each display, the duration of any unreserved air time period and to then remove the unreserved air time periods, if any (paragraph [0032]).

Claim 34, depending on claim 31, further recites that the sixth means for processing data in the form of scheduling servers 200/300/400 and their associated CPUs 210/310/410 (paragraph [0113]) comprise two further means, generally embodied in the form of the CPUs 210/310/410 (paragraph [0113]), to first determine, for each display, the duration of any unreserved air time period and to then fill the unreserved air time periods, if any, with compatible content (paragraph [0033]).

Claim 35, depending on claim 31, further recites that the sixth means for processing data in the form of scheduling servers 200/300/400 and their associated CPUs 210/310/410 (paragraph [0113]) comprise two further means, generally embodied in the form of the CPUs 210/310/410 (paragraph [0113]), to first determine, for each display, the duration of any unreserved air time period and to then remove the unreserved air time periods, if any (paragraph [0032]).

Claim 36, depending on claim 29, further recites that the broadband network 600 is a satellite network (satellite dishes 500 and satellite 550) (Fig. 1 and paragraphs [0054] and [0059]).

Claim 37, depending on claim 29, further recites that the broadband network 600 is a bi-directional network (Fig. 1 and paragraph [0054]).

Claim 38, depending on claim 29, further recites that the means for transmitting the data, in the form of network 700 and network 600 (Fig. 1 and paragraphs [0114] and [0115]), comprises a transmission control system 10 connected to the scheduling servers 200/300/400 (via a network 700, Fig. 1 and paragraph [0114]) and to the visual display sub-systems (via a satellite network 500/550, Fig. 1 and paragraph [0054]).

VI. Grounds of Rejection to be Reviewed on Appeal (37 CFR § 41.37(c)(1)(vi))



- Claim 29 is rejected under 35 USC § 112, first paragraph, for failing to comply with the written description requirement.
- Claims 28, 29, 31, 32, 36 and 38 are rejected under 35 USC § 102(b) as being anticipated by the U.S. Patent No. 5,566,353, granted to Nack Y. Cho and Jerry E. Magilton Jr. (hereinafter “Cho”).
- Claim 30 is rejected under 35 USC § 103(a) as being obvious over Cho in view of the U.S. Patent No. 7,039,784, granted to Monsong Chen, Dah-Weih Duan, Aparna Pappu et Bodhi Mukherjee (hereinafter “Chen”).
- Claim 37 is rejected under 35 USC § 103(a) as being obvious over Cho in view of the U.S. Patent No. 6,738,978, granted to John S. Hendricks and Alfred E. Bonner (hereinafter “Hendricks”).
- Claims 32-35 are rejected under 35 USC § 103(a) as being obvious over Cho in view of the U.S. Patent No. 6,075,551, granted to David Michael Berezowski, John Garret Thompson and Richard E. Millar (hereinafter “Berezowski”).

VII. Arguments (37 CFR § 41.37(c)(1)(vii))

For the sake of simplicity, references to the present application will be made using the paragraph numbering of the published application, namely publication no. U.S. 2003/0009762.

***The Examiner’s rejection of claim 29 under 35 USC § 112, first paragraph, is erroneous and should be reversed.***

In the final Office Action, the Examiner stated that the support for the limitation “second means for processing data to select and reserve one or more of said available

*air time periods in one or more of said playlists schedules to define said playlist schedules*” could not be found in the originally filed claims or specification.

The Appellant respectfully disagrees with the Examiner. As a matter of fact, though not recited *verbatim*, the support can be found in paragraph [0031] and more particularly in paragraph [0096] of the application which recites: “*h) second means for processing data to select and reserve available presentation time period on each said visual display sub-system*”.

From the above, only the portion reciting “*air time periods in one or more of said playlists schedules to define said playlist schedule*” differs from the originally recited limitation. Nevertheless, the skilled addressee will readily understand that “air time period” and “presentation time period” are synonymous expression. Indeed, in the context of the present invention, airing a clip or presenting a clip are totally equivalent concept.

The skilled addressee will then understand that you cannot actually “select and reserve air time directly on a display sub-system” since the sub-system does not actually have air time period *per se*. The latter is in fact a metaphoric way to recite that you “select and reserve air time in the playlist or playlists stored on and associated with the display sub-system or sub-systems” since it is the playlist that actually has the air time period. That the playlist data are stored at the display sub-system is disclosed at paragraph [0057].

Therefore, even though both limitations were not recited in the exact same way, it is respectfully believes that both limitations are fundamentally equivalent to each other. Accordingly, claim 29 and more particularly item c) are respectfully believed to be fully supported by the originally filed specification.

***The Examiner's rejection of claims 28, 29, 31, 32, 36 and 38 under 35 USC § 102(b) as being anticipated by Cho is erroneous and should be reversed.***

As preliminary notes, the Appellant understands that the field of multimedia display systems and methods is relatively crowded. As a matter of facts, numerous patents and technologies exist in this field as shown by the prior art.

Having a crowded technological field has the following consequence: new systems are mostly innovation over previous systems wherein one or more aspects have been improved, modified and/or changed. As a corollary, different systems may at first glance appear similar and therefore give rise to the erroneous belief that a new system is not.

Consequently, in the present case, the Appellant respectfully believes that its system, though sharing certain technological aspects with the system of Cho, still comprises fundamental and more importantly patentably distinguishing differences.

That being said, in his final Office Action, the Examiner has rejected claims 28, 29, 31, 32, 36 and 38 under 35 USC § 102(b) as being anticipated by the patent of Cho.

Section 102 of 35 USC reads as follows:

**35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless —

[...]

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

[...]

(emphasis added)

In order for a claim or claims to be anticipated under § 102(b), the claim or claims must be fully described in a single printed publication. In other words and as expressly recited in the MPEP, section 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (emphasis added)

Accordingly, in order for Cho to anticipate claims 28, 29, 31, 32, 36 and 38 of the Appellant's application, all the limitations of claims 28, 29, 31, 32, 36 and 38 of the Appellant's application must be found, expressly or inherently, in Cho's patent.

Though there may exist some similarities between both Cho's patent and the Appellant's application, there exist fundamental differences, clearly recited in the claims, that make the Appellant's invention patentably different from Cho's patent.

First, in claim 28, item f) recites: "on said scheduling server, inputting and storing data related to the multimedia content preferences of each user of a visual display system" (emphasis added) and in claim 29, item e) recites: "fourth means for inputting and storing data related to the multimedia content preferences of each user of a visual display system" (emphasis added).

In his examination report, the Examiner cited the following passages of Cho's patent as providing anticipatory disclosure with respect to the limitations of item f) of claim 28 and item e) of claim 29.

Column 11, lines 36-40:

"The Clip Library Database has, for example, (1) a table of valid clip types which includes a clip description along with valid run times for

each of the valid clip types, and (2) a video clip table which includes the clip number, the clip title, the clip type, the clip run time and the clip frequency rate.

The Template Database has, for example, (1) a table of playlist templates which includes the template ID, the creating operator, the date of creation, the finalizing operator and the date of finalization, and (2) a template ID contents table which includes sequence numbers, clip type and clip duration.”

Column 12, lines 54-67:

“At this point, the user can also edit a playlist and/or create a new playlist depending on the user's security level. To edit a playlist, the Edit Playlist Form 267 is loaded.

FIG. 7 is a process flow chart of the system's Edit Playlist Form. When the user selects the Edit Playlist option, the program enters the Edit Playlist Form 267 and displays a list of the contents of the selected playlist, the contents of the template used to construct that playlist, and the contents of the system's clip library (the clips being segregated by clip type) 270. The Template Database, the Playlist Database and the Clip Library Database provide the information needed for this display. The template used to construct the playlist is the backbone of the playlist.” (emphasis added)

Column 13, lines 1-6:

“For example, a template for a 30 minute wheel playlist may begin with a commercial clip, then a news clip, then a fact clip, then another commercial clip, etc. This ensures the balance of the playlist and

avoids any undesired order of certain clip types (e.g., 8 commercials in a row).”

First, even though column 11, lines 36-40, teaches the creation of templates, that does not mean that each user inputs his/her multimedia content preferences. As matter of fact, if a user of Cho’s system creates a particular template adapted to his/her particular needs, he/she may “input” his/her multimedia content preferences though he/she will prevent the other users from inputting theirs, which is contrary to the Appellant’s invention wherein each user inputs his/her multimedia content preferences.

With respect to column 12, lines 54-67, it discloses that a user, according to his/her security level, may edit a playlist. Here again, the user is not inputting his/her preferences, he/she is actually creating a playlist. The difference may be small but creating a playlist does not equal inputting multimedia content preferences in a database. As a matter of fact and as it will be explained in more details below, in the Appellant’s invention, the users (e.g. content providers) do not create playlists, they input their multimedia content preferences and their air time preferences and it is the system that creates the playlists according to the preferences each of the users. Therefore, by allowing user to directly create playlists, the invention of Cho teaches away from the present invention. In any case, if a user edits a playlist, he/she is not inputting his/her preferences, he/she is imposing his/her choices to the other users.

As for the passage of column 13, lines 1-6, it teaches only that a template may force certain clips to be placed at certain positions within the template. In fact, this passage is teaching away from the Appellant’s invention because a template is far from being a means by which you input preferences. According to the Merriam-Webster’s Collegiate Dictionary, a template is “something that establishes or serves as a pattern”. For the sake of completeness, a pattern is “something designed or used as a model for making things”. Accordingly, a template is almost the antithesis of

inputting preferences since you usually use a template not to have to take into account each preference of each user. If you use templates, it means that you want people to follow certain predetermined models, it also means you want a certain level of standardization in the created playlists whereas if you allow each user to input his/her preferences, it means you wish to provide fully customized playlists.

In other words, if you have templates, you do not need to have each user inputting his/her preferences. One excludes the other.

Therefore, the Appellant respectfully believes that the patent of Cho does not teach nor disclose means to input multimedia content preferences as understood and described in the Appellant's application.

Second, in claim 28, item g) recites: "on said scheduling server, inputting and storing data related to the air time period preferences of each user in said playlist schedule of a visual display system" (emphasis added) and in claim 29, item f) recites: "fifth means for inputting data related to the air time period preferences of each user in said playlist schedule of a visual display system" (emphasis added).

In his examination report, the Examiner cited the following passages as providing anticipatory disclosure with respect to the limitations of items g) of claim 28 and f) of claim 29.

Column 12, lines 62-67:

"[...] the contents of the template used to construct that playlist, and the contents of the system's clip library (the clips being segregated by clip type) 270. The Template Database, the Playlist Database and the Clip Library Database provide the information needed for this display. The template used to construct the playlist is the backbone of the playlist."

Column 13, lines 1-6:

“For example, a template for a 30 minute wheel playlist may begin with a commercial clip, then a news clip, then a fact clip, then another commercial clip, etc. This ensures the balance of the playlist and avoids any undesired order of certain clip types (e.g., 8 commercials in a row).”

The first passage teaches nothing, inherently or explicitly about inputting and storing air time period preferences. If the Examiner refers to the Template Database, the Playlist Database and the Clip Library Database as implicitly reciting the inputting and storing of air time period preferences, this is far from being obvious and it is certainly not an explicit teaching. In fact, none of these databases contains information about air time preferences of the users.

The Examiner may argue that a template inherently contains the air time preferences of a user. However, the limitations of claims 28 and 29 are clear about the fact that the air time preferences of each user are inputted. From the disclosure of Cho, it is not recited if a template includes the air time preferences of each user. On the contrary, the templates are most probably created by individuals having specific security level (see for instance column 12, lines 54-56). In any case, if the Examiner considered the creation of template as providing an inherent disclosure of inputting air time preferences, it was his duty to show the inherence. *Prima facie*, this is not the case.

As for the second passage, it too teaches nothing about inputting and storing air time period preferences. As a matter of fact, it only teaches that in a given template, the clips may be spread according to their type. Hence, commercial clips will likely be separated by other clips of different types to prevent “8 commercials in a row”. Nevertheless, the Appellant wonders how the separation of clips in a template can anticipate the “inputting and storing air time period preferences”. In the Appellant’s



opinion, a template is a predetermined structure which is generally not based on the preferences of each of the users. The users may prefer certain templates over others but the templates themselves do not take into account their preferences. In fact, as it will be shown in more details below, in the Appellant's invention, the users input their preferences in order for the system to generate an optimal playlist by correlating the multiple and possibly contradictory inputted preferences of all the users. Should the Appellant's invention use templates for its playlists, there would be no use whatsoever for the inputting and storing air time period preferences.

In Cho's invention, the templates have periods to be filled with clips of different types but the users cannot input their preferences, they can only use the air time periods provided by the templates. In other words, in the system of Cho, a user can select a period in a template only if it is available. The selected period may be the preferred period or it can be the second, third or even last choice. In any case, the user has not inputted his/her air time period preferences, he/she has inputted a clip in an available period.

Moreover, in Cho's invention, if a period in a template is already taken by a first user, than a second user, which prefers the period already taken, would have to select another period which may not be the preferred one.

The Examiner may argue that in the system of Cho, a user can edit the template or the playlist. However, only users having specific security level can do so (see column 12, lines 54-56). Thus, not all the users can do it. Moreover, by doing so, the user having the adequate security level is in fact imposing his/her preferences at the expense of the other users having lower security level. It is to be reminded that the limitations of claims 28 and 29 are clear to the effect that each user inputs his/her air time preferences.

Again, the difference may be subtle but it is present nonetheless. Is the Cho reference teaching the inputting and storing of air time period preferences of each user? The answer is clearly no. In the system of Cho, you do not input preferences, you input a clip in a valid and available period in a template, whether the period be your preferred one or not. In any case, the system of Cho does not allow each user to actively input his/her preferences with respect to air time periods in a database.

Consequently, the Appellant respectfully believes that the patent of Cho does not anticipate item g) of claim 28 nor item f) of claim 29. Accordingly, claims 28 to 38 are not anticipated.

Third and most importantly, in claim 28, item h) recites: “creating said playlists by **optimally correlating** said available air time periods, said air time period preferences and said multimedia content preferences” (emphasis added) and in claim 29, item g) recites: “sixth means for processing data to **determine for each visual display system, the actual playlist schedule by **optimally correlating** said available air time periods, said air time period preferences, and said multimedia content preferences**” (emphasis added).

In his examination report, the Examiner cited the following passages as providing anticipatory disclosure with respect to the limitations of items h) of claim 28 and g) of claim 29.

Column 12, lines 37-67:

“FIG. 6 is a process flow chart of the system's Socket Management Form. Playlist sockets are places where a "wheel" can be placed. When the user selects the PLAYLISTS option, the program enters the Socket Management Form 262 or 263 (depending on the user's security level) and displays a list of all store sites, the list of sockets for store no. 1 (as a default) and a list of all the available playlists 265. The user can then

move through the list of stores displaying the sockets for each store in the process. The Store Info Database and the Playlist Database provide the information needed for this display.

The user can then select from the available playlists to fill sockets of a particular store site 266. Each store site has its own number of sockets. For example, if a store is displaying 30 minute wheels of playlists for 18 hours (all the store's open hours), the store has 36 sockets which must be filled with wheels of playlists. At this point, the user can also edit a playlist and/or create a new playlist depending on the user's security level. To edit a playlist, the Edit Playlist Form 267 is loaded.

FIG. 7 is a process flow chart of the system's Edit Playlist Form. When the user selects the Edit Playlist option, the program enters the Edit Playlist Form 267 and displays a list of the contents of the selected playlist, the contents of the template used to construct that playlist, and the contents of the system's clip library (the clips being segregated by clip type) 270. The Template Database, the Playlist Database and the Clip Library Database provide the information needed for this display. The template used to construct the playlist is the backbone of the playlist." (emphasis added)

Column 13, lines 1-25:

"The template predefines the order of certain types of selected video clips. For example, a template for a 30 minute wheel playlist may begin with a commercial clip, then a news clip, then a fact clip, then another commercial clip, etc. This ensures the balance of the playlist and avoids any undesired order of certain clip types (e.g., 8 commercials in a row).

At this point in the program, the user can revise the playlist 271. The level of revisions available to the user depends on the user's security level. For example, if a user has a lower security level, the user may not be able to change any of the commercials in a playlist. Additionally, without regard to the user's security level, all playlists must conform to their respective templates.

The user can then opt to create a new template or save the playlist 274. If the user decides to create a new template, the program warns the user that all existing entries in the playlist will be removed/erased 272. The program then loads Open Template Form 273 (described below). If the user decides to save the playlist 274, the program (1) makes the corresponding changes to the Playlist Database and (2) uses the Store Info Database to notify the Uplink Database of all the stores that will need to receive the updated playlist and the updating video clips (the pending flag, introduced above, is also set at this time for additional video clips that need to be sent to stores).” (emphasis added)

First, a claim and its limitations must always be read in accordance with the specification. Therefore, when it is recited that the playlists are created by optimally correlating the available air time periods, the air time period preferences and the multimedia content preferences, it is not superfluous to go back to the specification to see what is meant by generating optimal playlists.

In the Appellant’s patent specification, paragraphs [0119] and [0120] recite the following:

“[0119] The needs and preferences of each advertiser and information provider who wishes to use the digital presentation system are gathered by the sales personnel and are inputted in the database

maintained in the central storage 120 via the workstations and Scheduling Servers. These preferences include demographics, multimedia content, airtime preferences and budgetary constraints. All of these preferences and constraints are entered into the central storage 120 via the Scheduling Servers 200, 300 and 400. Each workstation operator can reserve air time for display sub-systems located in his/her metropolitan area or indeed in any other display sub-system connected to the Transmission Control System 100 via the network 600.

[0120] Each workstation operator also has the option of using optimisation software contained in the Scheduling Servers to suggest a schedule to the client which will take into consideration the aforesaid constraints (demographics, content, air time and budget).”

From the foregoing, one question must be answered: Is the patent of Cho teaching or disclosing means to optimally correlate air time preferences, the multimedia content preferences and the available air time periods to generate playlists?

First, all the system of Cho is based on the concept of template. This fact is proven by numerous passages of Cho’s patent. For instance:

Column 12, lines 66-67: “The **template** used to construct the playlist **is the backbone of the playlist.**”

Column 13, lines 11-13: “Additionally, without regard to the user’s security level, all playlists **must conform to their respective templates**”.

How can playlists made according to templates anticipate playlists generated by optimally correlating the air time and multimedia content preferences of each user and the available air time periods?

In the system of Cho, the playlists are made according to predetermined templates which are static in nature. In the Appellant's invention, the playlists are created dynamically according to the preferences of the users and the air time availability. There is therefore a fundamental difference between both systems.

As a matter of fact, since the system of Cho is based on templates, why would his system comprise means to optimally correlate the preferences of the users and the air time availability to create playlists? There is in fact no such need and consequently, Cho is definitely teaching away from the Appellant's invention. Therefore, Cho's patent cannot anticipate neither claim 28 nor claim 29 since both claims explicitly recite the creation of playlists by optimally correlating preferences of the users and the air time availability.

Moreover, as explained above, Cho's system does not include means or steps to input and store the multimedia content preferences and the air time preferences of each of its user. Therefore, how could Cho's system anticipate the generation of playlists by optimally correlating preferences of the users and the air time availability if there are no means to input and store such preferences?

In conclusion, despite the fact that Cho's system and the Appellant's system share some attributes and despite the arguments of the Examiner, the Appellant has shown by the foregoing that the patent of Cho does not disclose key limitations of claims 28 and 29 and therefore does not anticipate the Appellant's invention. Furthermore, by virtue of claim dependency, claims 31, 32, 36 and 38 are also not anticipated.

***The Examiner's rejection of claim 30 under 35 USC § 103(a) as being obvious over Cho in view of Chen is erroneous and should be reversed.***

By virtue of claim dependency, since claim 29 is believed to be fully patentable over the prior art as discussed above, claim 30 is also believed to be patentable.

***The Examiner's rejection of claim 37 under 35 USC § 103(a) as being obvious over Cho in view of Hendricks is erroneous and should be reversed.***

By virtue of claim dependency, since claim 29 is believed to be fully patentable over the prior art as discussed above, claim 37 is also believed to be patentable.

***The Examiner's rejection of claims 32-35 under 35 USC § 103(a) as being obvious over Cho in view of Berezowski is erroneous and should be reversed.***

By virtue of claim dependency, since claim 29 is believed to be fully patentable over the prior art as discussed above, claims 32-35 are also believed to be patentable.

As a final note, it might be considered that our position with respect to the patentability of the currently rejected claims is shared by the European Patent Office since they have granted the Appellant a European patent for substantially similar claims.

The Appellant therefore respectfully requests that all the rejections of the Appellant's claims be withdrawn and the a timely notice of allowance be issued.

VIII. Claims Appendix (37 CFR § 41.37(c)(1)(viii))

**Claims**

1) (Cancelled)

2) (Cancelled)

3) (Cancelled)

4) (Cancelled)

5) (Cancelled)

6) (Cancelled)

7) (Cancelled)

8) (Cancelled)

9) (Cancelled)

10) (Cancelled)

11) (Cancelled)

12) (Cancelled)

13) (Cancelled)



14) (Cancelled)

15) (Cancelled)

16) (Cancelled)

17) (Cancelled)

18) (Cancelled)

19) (Cancelled)

20) (Cancelled)

21) (Cancelled)

22) (Cancelled)

23) (Cancelled)

24) (Cancelled)

25) (Cancelled)

26) (Cancelled)

27) (Cancelled)

28) (Previously amended) A method for the display of multimedia content on one or more display screens operatively connected to respective display controllers, said display of multimedia content being made according to playlists comprising multiple air time periods and stored on said display controllers, said display controllers being connected to a scheduling server and a transmission control system via a data communication network, said method comprising the following steps:

- a) selecting the multimedia content to be displayed;
- b) storing said multimedia content on said scheduling server;
- c) selecting one of said display screens on which said multimedia content is to be displayed;
- d) storing such display screen selection on said scheduling server;
- e) on said scheduling server, determining and storing data related to the availability of said air time periods of said playlists;
- f) on said scheduling server, inputting and storing data related to the multimedia content preferences of each user of a visual display system;
- g) on said scheduling server, inputting and storing data related to the air time period preferences of each user in said playlist schedule of a visual display system;
- h) creating said playlists by optimally correlating said available air time periods, said air time period preferences and said multimedia content preferences;
- i) transmitting said stored multimedia content and said playlists to said display controllers connected to said selected display screen;
- j) displaying said selected multimedia content on said selected display screen according to said playlists.

29) (Previously presented) A system to control the display of digital multimedia content on a plurality of out-of-home remote visual display systems connected together via a broadband network, wherein each said visual display system comprises an electronic multimedia display operatively connected to an associated display controller, said electronic multimedia display being arranged to be viewable by a plurality of passers-by, each of said display systems being adapted to cycle through a playlist schedule of

multimedia content, each said playlist schedules having a plurality of air time periods and being stored on respective said display controller, said control system comprising:

- a) at least one scheduling server operatively connected to said visual display systems, said at least one scheduling server comprising computer processor means and data storage means;
- b) first means for processing data from a database to determine the availability of said air time periods in each of said playlists schedules of each of said visual display systems;
- c) second means for processing data to select and reserve one or more of said available air time periods in one or more of said playlists schedules to define said playlist schedules;
- d) third means for processing data to respectively link to each of said reserved air time periods of each playlist schedule according to each of said playlist schedules, the multimedia content to be displayed by each of said visual display systems during said reserved air time periods, said third means for processing data further including means for transmitting said multimedia content and said playlist schedules to the corresponding one of said visual display systems.
- e) fourth means for inputting and storing data related to the multimedia content preferences of each user of a visual display system;
- f) fifth means for inputting data related to the air time period preferences of each user in said playlist schedule of a visual display system;
- g) sixth means for processing data to determine for each visual display system, the actual playlist schedule by optimally correlating said available air time periods, said air time period preferences, and said multimedia content preferences.

30) (Previously presented) A control system as claimed in claim 29, characterized in that each said visual display system further comprises means to request the transmission of said multimedia content or part of said multimedia content if said multimedia content or part of said multimedia content is not available on said storage means.

- 31) (Previously presented) A control system as claimed in claim 29, characterized in that it comprises means for inputting and storing demographic data in relation to the geographic location of each visual display system.
- 32) (Previously presented) A control system as claimed in claim 29, wherein said sixth means for processing data comprises:
- a) means to determine, for each said playlist associated to each visual display system the duration of any unreserved air time period,
  - b) means to fill each said unreserved air time period of said playlist with digital content which is compatible with the remaining multimedia content in the said corresponding predetermined air time period.
- 33) (Previously presented) A control system as claimed in claim 29, wherein said sixth means for processing data comprises:
- a) means to determine, for each said playlist associated to each visual display system the duration of any unreserved air time period,
  - b) means to remove each said unreserved air time period of said playlist.
- 34) (Previously presented) A control system as claimed in claim 31, wherein said means for processing data comprises:
- a) means to determine, for each said playlist associated to each said visual display system the duration of any unreserved air time period;
  - b) means to fill each said unreserved air time period of said playlist with digital content which is compatible with the remaining multimedia content in the said corresponding predetermined air time period.
- 35) (Previously presented) A control system as claimed in claim 31, wherein said means for processing data comprises:
- a) means to determine, for each said playlist associated to each visual display system the duration of any unreserved air time period,

b) means to remove each said unreserved air time period of said playlist.

36) (Previously presented) A system as claimed in claim 29, wherein said broadband network is a satellite network.

37) (Previously presented) A system as claimed in claim 29, wherein said broadband network is a bidirectional network.

38) (Previously presented) A control system as claimed in claim 29, wherein said means for transmitting data comprises a transmission control system connected to the scheduling server and the visual display systems.

IX. Evidence Appendix (37 CFR § 41.37(c)(1)(ix))

The following evidences are being submitted (in triplicate):

- Copy of the U.S. Patent No. 5,566,353, granted to Nack Y. Cho and Jerry E. Magilton Jr.;
- Copy of the U.S. Patent No. 7,039,784, granted to Monsong Chen, Dah-Weih Duan, Aparna Pappu et Bodhi Mukherjee;
- Copy of the U.S. Patent No. 6,738,978, granted to John S. Hendricks and Alfred E. Bonner;
- Copy of the U.S. Patent No. 6,075,551, granted to David Michael Berezowski, John Garret Thompson and Richard E. Millar;
- Copy of the pages of the Merriam-Webster's Collegiate Dictionary containing the definition of "template" and "pattern".

There is no further evidence submitted with this Brief of Appeal.

X. Related Proceedings Appendix (37 CFR § 41.37(c)(1)(x))

There is no related proceedings identified pursuant to 37 CFR § 41.37(c)(1)(ii).

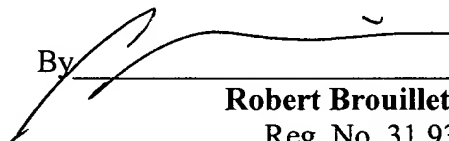
## Conclusion

In view of the foregoing, the Appellant respectfully submits that claims 28-38 are patentable over the cited prior art. Accordingly, it is respectfully requested that the Examiner's rejection be reversed.

All telephone conversations should be directed to Robert Brouillette at (514) 397-6900.

Respectfully submitted,

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